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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,278	03/15/2001	Robert Skvorecz	4336	9274

7590 12/14/2001

Eugene Lieberstein  
Anderson Kill & Olick  
1251 Avenue of the Americas  
New York, NY 10020-1182

[REDACTED] EXAMINER

LE, TAN

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3632

DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/772,278</b>	Applicant(s) <b>Skvorecz</b>
Examiner <b>Tan Le</b>	Art Unit <b>3632</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Mar 15, 2001

2a)  This action is **FINAL**.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-7 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 6 is/are allowed.

6)  Claim(s) 1-5 and 7 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This is the first office action for application serial number 09/772,278, Wire Chaffing Stand, filed on 03/15/01.
2. This application is a reissue of application 09/005,787 filed January 12, 1998 now as Patent No. 5,996,948 which issued on December 07, 1999. This reissue application contains 7 claims numbered 1-7. New claim 7 has been added which recites the limitations omitted from claim 1.
3. In the present reissue application, Applicants seek to delete from patent claim 1 the language underlined below to enlarge the scope of claim 1 of the patent, and to include it in a new dependent claim 7. In claim 1, the deletion of "a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area" (lines 5-10); the deletion of "at a location below the lower rim" (lines 14-15); and the deletion of "and to said lower rim at a relatively equal distance below the point of attachment to said upper rim" (lines 24-27) thus broaden the scope of the reissue claim 1 as a result of the deletion of the above limitations.
4. The issue of "***recapture***" as set forth in MPEP 1412.02 does appear to be at issue in the instant reissue application. The examiner has reviewed the patent file as to the changes made in the claims. An amendment was filed on July 26, 1999 after a first rejection. The amendment filed on July 26, 1999 (Paper No. 3 in the patented file) made changes to the independent claim 1 which involved changing "a pair of wire legs of equal length affixed at one end thereof to the

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upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire leg such that the upper rim and lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the lower rim to uniformly support the stand at opposing ends thereof and having a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween" to --a plurality of wire legs with each wire leg having two upright sections interconnected to one another *at a location below the lower rim* in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90 degrees with respect to a horizontal plane through said base support and being affixed to the upper rim adjacent one end thereof *and to said lower rim at a relatively equal distance below the point of attachment to said upper rim* and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said upper rim for laterally displacing each wire leg relative to said upper rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging--. Changes to claim 1 were made by Applicant in an effort to overcome the prior art rejection, especially the limitations (which were omitted in the reissue, as highlighted above) were in fact added in the original application claim 1 to overcome the prior art rejection to make the claims allowable. Applicants in the reissue claim has now attempted to modify those changes by deleting one of those limitations in the reissue claim 1 providing a broadening aspect relates to surrendered subject matter that Applicant previously surrendered-that is a recapture of subject matter that Applicant has given up. In

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addition to the changes above, Applicant also made an statement on the record that "Additionally, claim 1 requires each wire leg to have two upright sections which are interconnected to one another *at a location below the lower rim* in a configuration forming a base support for the stand to rest upon" (see page 4, lines 11-13 of the amendment filed on July 26, 1999 ). This statement is also sufficient to establish surrender and recapture.

Applicants asserting in the paragraph 4 of the new reissue declaration that "the error upon which this reissue is based relates to he inclusion in claim 1 and 3 of an unnecessary limitation which restricted the claims to a wire chafing stand having both an upper and lower rim and to the use of the term "plurality" before "wire legs" which may be improperly construed to represent "four" wire legs corresponding to the number shown in the drawings", thus the Applicant seeks to enlarge the scope of the claim 1 of the patent, and was properly filed within two years from the grant of the patent, as provided by the fourth paragraph of 35 U.S.C 251. However, based on the review of the patent file, the examiner considers the narrow scope of the claim 1 in the patent file was not an error within the meaning of 35 U.S.C 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The examiner also disagrees with Applicant's statement in the paragraph 9 of the reissue declaration that the patentability was based upon the requirement as written. The patentability was based upon a plurality of wire legs with each wire leg having two upright sections interconnected to one another *at a location below the lower rim*... with each upright stand section from the base support to form an angle equal or greater than 90 degrees... and being affixed to the upper rim

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adjacent one end thereof ***and to the lower rim at a relatively equal distance below the point of attachment to the upper rim***... (see notice of allowance of August 12, 1999, Paper No. 5). The omitted limitations as highlighted above were in fact part of the examiner's reasons for allowance in the original application.

5. § 1.175 Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(I) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

© Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

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- (d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

***Defective oath***

6. The reissue oath/declaration filed with this application is defective and not sufficient because:

- (a) the reissue declaration omits the post office addresses for the inventor, and country of citizenship as required by 37 CFR 1.63(a) (3).
- (b) the reissue oath/declaration filed with this application is defective because it fails to contain a statement “**all errors being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant**”. See 37 CFR 1.175 and MPEP § 1414.

8. Claims 1-5 and 7 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the reissue declaration is set forth in the discussion above in this Office action.

9. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Should additional errors be found, note that the below may be beneficial to applicants pursuant to MPEP 1444 it that the reissue oath or declaration must include this statement

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"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

*Recapture*

10. Claims 1-5 and 7 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

In the present reissue application, Applicants seek to delete from patent claim 1 the language underlined below to enlarge the scope of claim 1 of the patent, and to include it in a new dependent claim 7. The deletion of "a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area" (lines 5-10); the deletion of "at a location below the lower rim" (lines 14-15); and the deletion of "and to said lower rim at a relatively equal distance below the point of attachment to said upper rim" (lines 24-27) thus broaden the scope of the reissue claim 1 as a result of the deletion of the above limitations.

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The issue of “*recapture*” as set forth in MPEP 1412.02 does appear to be at issue in the instant reissue application. The examiner has reviewed the patent file as to the changes made in the claims. An amendment was filed on July 26, 1999 after a first rejection. The amendment filed on July 26, 1999 (Paper No. 3 in the patented file) made changes to the independent claim 1 which involved changing “a pair of wire legs of equal length affixed at one end thereof to the upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire leg such that the upper rim and lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the lower rim to uniformly support the stand at opposing ends thereof and having a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween” to --a plurality of wire legs with each wire leg having two upright sections interconnected to one another *at a location below the lower rim* in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90 degrees with respect to a horizontal plane through said base support and being affixed to the upper rim adjacent one end thereof *and to said lower rim at a relatively equal distance below the point of attachment to said upper rim* and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said upper rim for laterally displacing each wire leg relative to said upper rim to facilitate the nesting of a multiplicity of stands into one another without significant

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wedging--. Changes to claim 1 were made by Applicant in an effort to overcome the prior art rejection, especially the limitations (which were omitted in the reissue, as highlighted above) were in fact added in the original application claim 1 to overcome the prior art rejection to make the claims allowable. Applicants in the reissue claim has now attempted to modify those changes by deleting one of those limitations in the reissue claim 1 providing a broadening aspect relates to surrendered subject matter that Applicant previously surrendered—that is a recapture of subject matter that Applicant has given up. In addition to the changes above, Applicant also made an statement on the record that "Additionally, claim 1 requires each wire leg to have two upright sections which are interconnected to one another *at a location below the lower rim* in a configuration forming a base support for the stand to rest upon" (see page 4, lines 11-13 of the amendment filed on July 26, 1999 ). This statement is also sufficient to establish surrender and recapture.

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by the fourth paragraph of 35 U.S.C 251. However, based on the review of the patent file, the examiner considers the narrow scope of the claim 1 in the patent file was not an error within the meaning of 35 U.S.C 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The examiner also disagrees with Applicant's statement in the paragraph 9 of the reissue declaration that the patentability was based upon the requirement as written. The patentability was based upon a plurality of wire legs with each wire leg having two upright sections interconnected to one another *at a location below the lower rim*... with each upright stand section from the base support to form an angle equal or greater than 90 degrees... and being affixed to the upper rim adjacent one end thereof *and to the lower rim at a relatively equal distance below the point of attachment to the upper rim*... (see notice of allowance of August 12, 1999, Paper No. 5). The omitted limitations as highlight above were in fact part of the examiner's reasons for allowance in the original application.

11. The original patent file has been reviewed. All prior art therein has been considered. No copies are being furnished since Applicants have previously been supplied with copies.

12. Any inquiry concerning this communication should be directed to Tan Le, whose telephone number is 703.305.8244.

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Any inquiry of a general nature or relating to the status of this Application should  
be directed to the Group receptionist at 703.308.2168.

Tan Le  
Patent Examiner  
Art Unit 3632  
November 27, 2001.

  
**RAMON O. RAMIREZ**  
**PRIMARY EXAMINER**  
**ART UNIT 355-3632**